

REMARKS/ARGUMENTS

The office action of November 4, 2004 has been carefully reviewed and these remarks are responsive thereto. The listing of pending claims 1-20 and 46 are provided for the examiner's convenience only; no amendments are made in the present response. Reconsideration and allowance of the instant application are respectfully requested.

Allowed Subject Matter

Claims 2-3 and 9-11 are objected to as being dependent on a rejected base claim, but would be allowable if rewritten in independent form, including the limitations of any intervening claims. Applicants have not amended the claims at this time, based on the allowability of the rejected base claims as set forth below.

Rejections Under 35 U.S.C. § 103

Claims 1, 4-8, 12-20 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson *et al.* (U.S. 2002/0004424, hereinafter Nelson) in view of Kagan *et al.* (U.S. Pat. No. 5,618,045, hereinafter Kagan). This rejection is respectfully traversed for at least the following reasons.

In order to reject a claim as obvious under § 103(a), three criteria must exist: 1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings; 2) there must be a reasonable expectation of success; and 3) the prior art reference(s) must teach or suggest all the claim limitations. *See* MPEP § 706.02 (j); *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). In the present case, there is neither a motivation to combine the references, nor does the combination, even if combined, teach or suggest every element of any independent claim.

No Motivation to Combine the References

The Office Action indicates that it would have been obvious to combine Nelson and Kagan "in order to facilitate interaction play between the players." However, this is not a

motivation to combine the references, but is the end-result of the combination taught by Applicant's own disclosure. Even assuming that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, as is often argued by the Office, the Office Action provides no evidence that the combination takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, nor does the Office Action provide any evidence that the combination does not include knowledge gleaned only from Applicant's disclosure, as would be required in order to make such a combination. Thus, the combination is an improper combination based on hindsight.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that there is no motivation or suggestion to combine Nelson with Kagan.

Further, modification of Nelson as proposed by the office action would destroy its intended functionality. It is well grounded that a proposed modification would not have been obvious if it destroys a reference's intended functionality. See e.g., *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Nelson states, at para. [87], "[p]referably, multiple players could be playing the same game at the same time, but *each of the games are independent of each other*" (emphasis added). Modifying Nelson as suggested by the office action destroys this intended functionality.

The References do not Teach or Suggest All the Claim Limitations

Even if Nelson is improperly combined with Kagan, the improper combination does not teach or suggest all the limitations of any claim.

For example, claim 1 recites a mobile terminal "forwarding the task for delivery to a second mobile terminal." The Office Action correctly indicates that Nelson does not disclose forwarding the task to a second mobile terminal. The Office Action goes on to argue, however, that Nelson describes a task passing function, and that Kagan suggests transmitting actions to

other player terminals. The implication is that the combination therefore describes forwarding the task for delivery to a second mobile terminal.

However, there is a flaw with this argument because the examiner is misreading the Nelson reference. Neither reference teaches or suggests forwarding the task for delivery to a second mobile terminal. The “passing function” of Nelson, which is referred to by the Office Action, is actually a function to *skip* a question altogether, not pass an action to another player. That is, the Nelson reference uses the word “pass” to indicate that a question is skipped. Nelson states “by pressing the ‘pass’ button, a player advances to the next question without being required to answer the current question...” Nelson at [65]. The examiner is unilaterally changing the use of the word “pass” in Nelson to apparently mean “send to another player,” which is improper. Applicants submit that one of ordinary skill in the art, upon reading Nelson, would not read Nelson to teach or imply that a task can be passed (i.e., sent), from one player to another.

Kagan, also, does not teach or suggest such a feature. Kagan describes sharing player actions or setting up ad-hoc networks. Kagan does not teach or suggest the recited step of receiving a task from a network or game server, or forwarding a task to another player, as claimed. Thus, even if improperly combined, the references do not teach or suggest forwarding the task for delivery to a second mobile terminal.

With respect to claim 14, the improper combination of Nelson with Kagan similarly does not teach or suggest the mobile terminal forwarding the task to a different mobile terminal.

With respect to claim 46, the improper combination of Nelson with Kagan similarly does not teach or suggest a mobile terminal passing the game task to another player.

Claims 4-8 and 12-20 are allowable for all the reasons given above concerning their respective base claims, and further in view of their specific recitations that have not been shown to be in (or obvious from) the prior art. Applicants therefore respectfully request the rejection be withdrawn.

Appln. No.: 10/017,382
Amendment dated January 10, 2005
Reply to Office Action of November 4, 2004

CONCLUSION


All rejections having been addressed, Applicants respectfully submit that the instant application is in condition for allowance, and solicit prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

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Dated this 10 day of Jan., 2005

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